



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,835	01/11/2001	K. Scott Kammerer	12714	8539

7590

10/07/2003

Donald J. Breh
Illinois Tool Works Inc.
3600 West Lake Avenue
Glenview, IL 60025

EXAMINER

SPISICH, MARK

ART UNIT

PAPER NUMBER

1744

DATE MAILED: 10/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/758,835

Applicant(s)

KAMMERER ET AL.

Examiner

Mark Spisich

Art Unit

1744

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to **make** and/or use the invention. The present application relates to a static-dissipative swab comprising a handle as well as a cleaning tip. The prior art devices also include a handle as well as a cleaning tip. Applicant's specification (paragraph 0005) also describes that it is known in the art to provide a static-dissipative swab comprising a static-dissipative handle as well as a cleaning tip of polyester. Applicant then makes the assertion that the swab of the present application performs a particular function (in lines 8-13 of claim 1) and that the prior art does not; however, there is **NO** disclosure of the particular materials which make up the present "swab" which enable it to function as described and which would structurally define over that of the prior art. For example, applicant discloses that the swab of the present application may include a cleaning tip formed from polyester (paragraph 0023, line 3), while the admitted prior art also has a static-dissipative handle and a polyester cleaning tip (paragraph 0005) and there is **NO** mention of what is different about the swab of the present application and that of the prior art (which also

Art Unit: 1744

includes the prior art made of record by the examiner in the prior office action). If there is a structural difference between the swab of the present application and that of the prior art which constitutes an improvement over the prior art and which enables it to function as described, there is no mention of it,

3. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are indefinite for much the same reason(s) set for above with respect to the 112, 1st rejection. In addition, claims merely setting forth physical characteristics desired in an article, and not setting forth specific compositions which would meet such characteristics are vague, indefinite and functional. Ex parte Slob (PO BdApp) 157 USPQ 172. This matter is complicated in the present instance in that the materials of the claimed swab which would allegedly be the improvement or the structure which might define over the structure of the prior art are not disclosed with any specificity to define over the structure of the prior art.

Comment Re Application of Prior Art

As mentioned in the prior office action, the claims have been given their broadest reasonable interpretation.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1744

5. Claims 1,5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pisacane et al (USP 5,460,655) in view of the admitted prior art of paragraph 0005. The patent to Pisacane discloses a swab (40) (see fig 4 as well as column 3, lines 23-30) comprising a handle (of polypropylene) on which is secured an open-cell, hydrophilic, **static-dissipative**, polyurethane foam (see column 3, lines 4-5). The patent to Pisacane discloses fails to specific whether the polypropylene handle is "static-dissipative". As admitted in paragraph 0005 of the present application, it is known in the art that a static-dissipative swab be comprised of a static-dissipative handle mounting a static-dissipative tip. As such, it would have been obvious to have modified the swab of Pisacane to further prevent the forming of a static charge on the surface being cleaned. A static-dissipative foam would, to function as such, be "conductive" as in claim 5. With regard to claim 6, one of ordinary skill would deem it obvious to utilize dissipative polyurethane foams of any available pore size based on the intended surface to be cleaned.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 1 above, and further in view of Ito et al (USP 4,741,066). The patent to Pisacane discloses the use of a polymeric handle material and fails only to disclose the specific material of claim 2. The patent to Ito discloses the use of polybutylene terephthalate (see column 2, lines 54-56) along with some other constituents *and as such is "modified" insofar as this term is defined in the present application). It would have been obvious to one of ordinary skill to have used any such

Art Unit: 1744

material recognized by the art as suitable for implement handles based on ease of manufacture, etc.

7. Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 1 above, and further in view of Halford et al (USP 4,401,130). The patent to Pisacane discloses a swab in the embodiment of fig 4 and fails only to disclose the foam portion in the form of a seamless tube (essentially the embodiment of fig 3 of the present application). The patent to Halford discloses a cleaning swab wherein the swab material (1) is in the form of a seamless tube which is then bonded or otherwise secured to a handle (2). One of ordinary skill in the art would deem it obvious to utilize any known methods of securing a foam swab to a handle (and which are taught by Halford). With regard to the "tube", one of ordinary skill would deem it obvious to utilize various shapes of the cleaning tip including to tube shape of Halford so that it might be better used to clean tubes.

8. Claims 1,3,4, and 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burrow et al (USP 5,214,821) in view of the admitted prior art of paragraph 0005. The patent to Burrow discloses a swab for cleaning electrical equipment in a cleanroom environment comprising a handle (10) of nylon (see column 5, line 26) and further including a tubular knit polyester fabric (14) (see column 4, lines 9-10) spirally wound onto the handle and thermally sealed thereto (the particular manner of thermally attaching the two relates to the method of manufacture and is not germane to the patentability of the device itself). Applicant has defined the cleaning tip as being a knit tube of polyester, which is taught by Burrow. With regard to the material

Art Unit: 1744

of the handle, applicant's admission in paragraph 0005 states that the use of such a material is known in the art and that it would have been obvious to one of ordinary skill to have modified the device of Burrow so as to reduce or eliminate the creation of static charge (especially given the disclosed use of the device of Burrow in a cleanroom).

Response to Arguments

9. Applicant's arguments filed 13 August 2003 have been fully considered but they are not persuasive. The present invention relates to an alleged improvement of a cleaning swab which dissipates static charge. Without disclosing ANY specific materials which would enable the swab of the present invention to function as claimed, applicant is arguing that this alone is enough to distinguish over the prior art. In fact, applicant has an embodiment which includes a static dissipative handle and a polyester cleaning tip (paragraph 0023, line 3), neither of which are disclosed as having any special composition. This embodiment would structurally be the same as that of the prior art swab described in paragraph 0005. If there is some modification of the admitted prior art which produces the alleged results, they are nowhere to be found in the specification. "112-1st" requires that the specification enable one of ordinary skill to **make** and use the claimed invention. How can applicant argue that the prior art which is made of the same basic components (as disclosed) as the claimed invention fails to meet the claim when the present specification does not disclose a material or structural distinction in the first place?

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Spisich whose telephone number is (703) 308-1271. The examiner can normally be reached on M-Th (6-3:30), Alternate Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J Warden can be reached on (703) 308-2920. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Mark Spisich
Primary Examiner
Art Unit 1744

MS